

81. The method of claim 80 wherein said composition comprises a product produced by the process of combining said superabsorbent polymer with said siloxane and optionally, said lubricant additive.

REMARKS:

Written Statement Pursuant to 37 C.F.R. § 1.133

Applicant's attorney submitted the foregoing amendment to the claims by facsimile on April 30, 2003 and discussed them with the Examiner by telephone on May 12, 2003. He pointed out that claim 78 incorporated all of the limitations of dependent claim 62 that the Examiner indicated she would allow in the April 9 Office Action, and claim 80 incorporated all of the limitations of dependent claim 72, also indicated as allowable in the April 9 Office Action.

Applicant's attorney also requested that the Examiner give favorable consideration to product-by-process claims 79 and 81, dependent respectively on claims 78 and 80. Claims 79 and 81 follow the same product-by-process format of cancelled claims 65 and 75, introduced to provide the scope of protection for the invention that the Court of Appeals for the Federal Circuit indicated would cover a lubricant composition if in fact the components of the composition reacted with one another after combining them. See Exxon Chem. Patents, Inc. v. Lubrizol Corp., 64 F. 3d 1553, 35 U.S.P.Q. 2d 1801 (Fed. Cir. 1995), cert. denied, 116 S. Ct. 2554 (1996). Importantly, the written description of the present application also supports these claims

at page 21, lines 1-8, referring to instances where the components may react with one another and therefore describes the invention as a product made by the process of combining the lubricant components.

The Examiner said she would take the foregoing amendments under advisement.

Conclusions

Applicant requests that the Examiner pass claims 78-81 to issue for all of the foregoing reasons.

Respectfully submitted,

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Dated: May 13, 2003

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Services pursuant to 37 C.F.R. § 1.8 on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria Virginia 22313-1450.

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Dated: May 13, 2003